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| APPLICATION NO.                                                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/934,047                                                      | 08/22/2001  | Barry M. Epstein     |                     | 7788             |
| 7590                                                            | 07/13/2004  |                      | EXAMINER            |                  |
| Terry M. Gernstein<br>1015 Salt Meadow Lane<br>McLean, VA 22101 |             |                      |                     | NGUYEN, DANNY    |
|                                                                 |             | ART UNIT             | PAPER NUMBER        | 2836             |

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                   |
|------------------------------|-----------------|-------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)      |
|                              | 09/934,047      | EPSTEIN, BARRY M. |
| Examiner                     | Art Unit        |                   |
| Danny Nguyen                 | 2836            |                   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4-10,12-23,25,27-55,59,60 and 63-99 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 34-41 and 88-90 is/are allowed.

6) Claim(s) 1,2,4-10,12-23,25,27-33,42-55,59,60,63-87,91-99 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.                                               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 17, 34, 42, 48, 54, 70, 88, 91, 93, and 97 have been considered, but are moot in view of the new ground(s) of rejection.

2. The indicated allowability of claims 50-52 are withdrawn in view of the newly discovered reference(s) to Allison (USPN 5,511,840) and Charles N. Gosnell (USPN 3,587,098). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 47, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claims 3, 11, 24, 26, 56-58, 61, and 62 are cancelled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 67-69, 99 are rejected under 35 U.S.C. 102(b) as being anticipated by English et al (USPN 5,335,137).

Regarding claims 67 and 69, English discloses a method of protecting a person or equipment from surprise, damaging or uncomfortable electrostatic discharge (ESD) comprises performing a task (device 10 shown in fig. 1 which is used by a person performing a task); providing an electrostatic discharge contact element (contact element 22); repeatedly contacting the contact element while performing the task; and preventing current from the ESD from instantaneously building up during each contact of the contact element (e.g. col. 4, lines 26-55).

Regarding claim 68 and 99, English discloses a system for protecting a person or equipment from surprise, damaging or uncomfortable electrostatic discharge (ESD) comprises a device (such as device 10 shown in fig. 1) used by a person to perform a task; an electrostatic discharge contact element (such as contact element 22) which is located on the device and which is adapted to be contacted repeatedly by the person while the person performs the task; means (means shown in fig. 6) for preventing current from the electrostatic discharge contact element from instantaneously building

up during each contact of the electrostatic discharge contact element; and means (means 64) for grounding said electrostatic discharge contact element (e.g. col. 4, lines 26-55).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 59, 60, 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over English et al in view of Dalal (USPN 4,642,727).

Regarding claims 59, 60, 63, 64, 65, English discloses a method and apparatus for protecting equipment from ESD comprises a device (device 10 shown in fig. 1) which is used by a person to perform a task, an contact element (such as contact element 22) which is located and adapted to be contacted repeatedly by the person while the person is performing the task (user repeatedly contacts the contact element 22 while performing the task), means (such as 64 shown in fig. 6) for grounding the contact element. English does not disclose means for reducing RFI associated with an ESD event. Dalal discloses an ESD protection circuit comprises a means (such as means 50) reducing RFI associated with an ESD event (e.g. col. 1, lines 40-47 and col. 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ESD protection circuit of English to corporate the

element for reducing RFI as taught by Dalal in order to protect electronic equipment against RFI (see abstract).

Regarding claim 66, English discloses a plurality of contact elements (such as 14 and 16 shown in fig. 1).

7. Claims 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over English et al in view of Pritchard (USPN 4,958,255).

Regarding claim 80, English discloses a system for protecting a person or equipment from surprise, damaging or uncomfortable electrostatic discharge (ESD) (fig. 1 and 6) comprises a device, (10) which is used by a person to perform a task; an electrostatic discharge contact element (22) which is located and adapted to be repeatedly contacted by the person while the person is performing the task, a discharge circuit (discharge circuit shown in fig. 6) which includes a first resistor element (e.g. resistor Rp, col. 4, lines 46-50) in series with the contact element and which has a resistance in excess of five megohm ; a ground element (64) electrically connected to the discharge circuit. English does not disclose an inductor element. Pritchard discloses an ESD protection circuit comprises an inductor element (44 shown in fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ESD protection circuit of English to incorporate the inductor element as taught by Pritchard in order to minimize electromagnetic interference (col. 3, lines 45-49).

Regarding claim 81, English discloses a plug (device 10 shown in fig. 1 which inherently includes a plug in order to connect device 10 to computer).

8. Claims 1, 2, 6, 9, 12, 14, 17, 18, 19, 25, 42, 43, 44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison et al (USPN 5,511,840) in view of Ker (USPN 5,901,022). Allison discloses a system for protecting equipment from ESD comprises vacuum wand used by a person performing a task and ESD contact element (the wand 12) which is held by the user which reads on repeatedly contacted by a person while the person is performing a task, discharge circuit includes a resistance element (col. 2, line 64). Allison does not disclose an inductor as claimed. Ker discloses an ESD circuit that has an inductor (see fig. 8)connected to the contact element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Allison to include an inductor for purpose of directing the ESD event through the ESD protection device and provides an extra degree of isolation to the protected device.

9. Claims 50-52, are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison et al in view of Charles N. Gosnell (USPN 3,587,098). Allison discloses a system for protecting equipment from ESD comprises vacuum wand used by a person performing a task and ESD contact element (the wand 12) which is held by the user which reads on repeatedly contacted by a person while the person is performing a task, discharge circuit includes a resistance element (col. 2, line 64). Allison does not

disclose a litz wire as claimed. Gosnell teaches that using litz wires bend easily (col. 2, lines 34-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Allison to include litz wires as taught by Gosnell because the litz wires provide flexibility to the system.

10. Claims 1, 2, 4-7, 10-18, 27, 42-44, 46- 49, 54, 70-73, 78, 79, 83, 84, 86, 87, 93-95, 97, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over English et al (USPN 5,335,137) in view of Ker (USPN 5,901,022). English discloses a system for protecting equipment from ESD comprises a device (keyboard 10 shown 1) which is used a person performing a task, a contact element (such as 22) ((the spacebar 22 is repeatedly contacted by a person), a discharge circuit (a discharge circuit shown in fig. 6) includes a resistor (Rp) and a ground (64). English does not disclose an inductor as claimed. Ker discloses an ESD circuit that has an inductor (see fig. 8)connected to the contact element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Allison to include an inductor for purpose of directing the ESD event through the ESD protection device and provides an extra degree of isolation to the protected device.

11. Claims 20-23, 27-33, 55, 75-77, 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over English et al in view of Ker, and further in view of Banner (USPN 3,924,914). English and Ker disclose all limitations of claim 1 as discussed above, but do not disclose a plug as claimed. Banner discloses a system for protecting equipment

from ESD comprises a plug (fig. 11) comprises a test circuit (test circuit 9), a ground prong (e.g. 8), neutral prong, a hot prong, female receptacles (37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of English and Ker to include a plug as taught by Banner in order to protect person or equipment against electrostatic discharge.

12. Claims 8, 45, 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over English et al in view of Ker, and further in view of Pritchard. English and Ker disclose all limitations of claims 1 and 42 as discussed above, but do not disclose a capacitor. Pritchard discloses an ESD protection circuit comprises a capacitor element (46 shown in fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ESD protection circuit of English to incorporate the capacitor element as taught by Pritchard in order to minimize electromagnetic interference (col. 3, lines 45-49).

#### ***Allowable Subject Matter***

13. Claims 34-41, 88-90, are allowed.

#### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

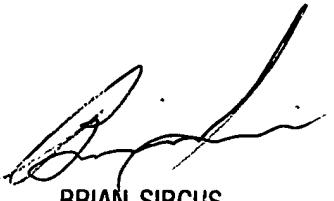
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Nguyen whose telephone number is (571)-272-2054. The examiner can normally be reached on Mon to Fri 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571)-272-2058. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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7/6/2004



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